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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,497	12/03/2001	Rainer Graefe	Mo6566/LeA 34,399	8050

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EXAMINER

REDDICK, MARIE L

ART UNIT PAPER NUMBER

1713

DATE MAILED: 09/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/006,497

Applicant(s)

GRAEFE ET AL.

Examiner

Judy M. Reddick

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1713

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 and 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vanderbilt et al(U.S. 3,447,552) in combination with applicants' own disclosure.

Vanderbilt et al disclose and exemplify coagulated compositions formed basically via mixing a combination of a latex of an organic peroxide, curable NBR rubbery polymer comprising 55 to 75 wt.% of butadiene and 25 to 45 wt.% of acrylonitrile, a powdered polyvinyl chloride, an unsaturated polyester and other conventional adjuncts which include those that function as a coagulating agent and wherein the ingredients are mixed at a compounding temperature of 310 degrees F(154 degrees C) and cooled to a temperature of 130 degrees F(54 degrees C), sufficient to meet the limitations per claim 5. See col. 1, lines 43-65, the paragraph bridging cols. 1 and 2, col. 3-7, Runs I, II and VI and the claims. Vanderbilt et al @ col. 2, lines 26-28, teach that the latices of the NBR rubbery polymer and the polyvinyl chloride may be mixed and coprecipitated and that it is preferred to blend 100 to 300 parts of polyvinyl chloride per 100 parts by weight of the NBR rubbery polymer(sufficient to meet the limitations per claim 3).

The disclosure of Vanderbilt et al differs basically from the claimed invention as per the non-express disclosure of an embodiment directed to the specifically defined polyvinyl chloride component, as claimed(see claim 1). However, applicant at page 3 states that the polyvinyl chlorides useable in the claimed invention are commercially well known and to this end, it would have been obvious to the skilled artisan following applicants'

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guidelines @ page 3, lines 21-24, to use any commercially available polyvinyl chloride governed by the claimed particle size and K values in lieu of the polyvinyl chloride component of the rubbery composition of Vanderbilt and with a reasonable expectation of success, absent a clear showing of unexpected results commensurate in scope with the claims. Moreover, the polyvinyl chloride component per Vanderbilt et al is generic to the claimed polyvinyl chloride component, in terms of particle diameter and K value range, and therefore would necessarily imply that any polyvinyl chloride including the claimed polyvinyl chloride would have been operable within the scope of patentees invention and therefore obvious to the skilled artisan and with a reasonable expectation of success. Criticality for such, clearly commensurate in scope with the claims, not having been demonstrated on this record. Further, even if it turns out that the processing(mixing) temperatures per Vanderbilt et al(Run VI) are slightly higher than the claimed mixing parameters, it would have been obvious to the skilled artisan, via routine experimentation and in accordance with property optimization, to alter the mixing temperature of Vanderbilt et al and with a reasonable expectation of success. Criticality for such, clearly commensurate in scope with the claimed invention, not having been demonstrated on this record.

Response to Arguments

3. Applicant's arguments filed 06/27/03 have been fully considered but they are not persuasive.

Relative to Vanderbilt et al---The crux of Counsel's arguments appear to hinge on the impropriety in using Vanderbilt et al in combination with applicants' own disclosure to make out a prima face case of obviousness based on the "polyvinyl chloride" component, as claimed. With all due respect to Counsel's opinion, when applicant states that something is prior art, it is taken as being available as prior art against the claims. Admitted prior art can be used in obviousness rejections. In re Nomiya, 509 F.2d 566, 184 USPQ 607, 611 (CCPA 1975). It is urged and maintained that the instantly claimed

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invention is obvious within the meaning of 35 USC 103 over Vanderbilt et al as per reasons clearly set forth in the Grounds of rejection set forth supra.

Conclusion

4. The additional prior art to Schwarz(U.S. 4,438,230) and Ngoc(U.S. 5,552,468) are cited as of interest in teaching NBR/polyvinyl chloride blends and considered merely cumulative to the prior art supra.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.

Judy M. Reddick
Primary Examiner

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JMR
9.16.03